

REMARKS

I. Examiner Telephone Interviews of October 7 and 24, 2005

The Applicant hereby gratefully acknowledges the telephone interviews that Examiner Nguyen granted the Applicant's Attorney on October 7 and 24, 2005.

II. Response to Examiner's Claim Rejections

Briefly given below is the substance of the Applicant's arguments for claim allowance that were advanced to the Examiner during the October 7 and 24, 2005 telephone interviews. At the end of these conversations, the Applicant believes that he heard the Examiner acknowledge that:

- (a) her cited reference (Newbold) does not disclose the third step in the Applicant's process Claim 1, and
- (b) therefore, the Examiner would discuss this matter with her Primary Examiner with the expectation of granting allowance of the Applicant's independent Claim 1 and its dependent claims 2-10 (and presumably also, similarly worded independent claims 11 and 21 and their dependent claims 12-20 and 22-30).

Given below for the Examiner's reconsideration is the text of my October 24, 2005 email communication to the Examiner which presented the Applicant's arguments and reasoning which were the basis for the agreements which were believed to have been reached during the October 24, 2005 telephone interview.

In order to put this email in context, also shown below is the text of my October 6, 2005 email communication to the Examiner which presented the Applicant's arguments and reasoning that were discussed in the October 7, 2005 telephone interview and which led to the follow-up telephone interview of October 24, 2005.

10/24/05 Email, Informal Communication:

I think we agreed in Friday's telephone conversation to focus our attention on element 3 of Claim 1: "inserting said marking into said electronic writing so as to create a version of said

electronic writing that has inserted into said version at least one of said insertable editorial markings.”

On page 3, para. (iii) of your 7/8/05 Final Office action, you imply that the above underlined portion of this element can be found in Newbold at “col. 8, lines 42-54.”

However, the Applicant maintains that this is clearly wrong as these lines can be seen to describe Newbold’s “Proofreading Screen” and his “Error List Window”; see his FIG. 5B. These are just two elements that Newbold’s invention creates for use with his Text Window – these elements do not show or create “any version of the electronic writing to be edited” – much less one with “inserted editorial markings.” Newbold’s Proofreading Screen, with its 500, 502 and 504, shows only information pertaining to how to correct the current error that is highlighted in the Text Window where the electronic writing is displayed, while his Error List shows only a listing of the various errors that have been identified in the electronic writing.

The validity of the above statements are clearly seen by examining a simplified version of col. 8, lines 42-54 which reads as follows:

“The 500 is filled with a DM regarding the CE, and the 502 is filled with the MLC at ... 404. The MLC is the FCS ... 504 is filled with the MLC at .. 406.

If the EL is not opened at .. 408 .. processing continues at .. 412 ... If the EL is opened, the CE is located in the EL and highlighted at .. 410,”

where 500=Message Window, DM=Descriptive Message, CE=Current Error, 502=Suggestion Window, MLC=Most-Likely Correction, FCS=First Correction Suggestion, 504=CorrectWith, and EL=Error List or Error List Window.

In our Friday conversation, you asked about my client’s “version of said electronic writing that has inserted into said version at least one of said insertable editorial markings.” This is clearly shown in his FIG. 9(a).

Applicant maintains that it is illogical to even think that Newbold could disclose such an element. The reason for this belief is that Newbold’s invention is intended only for use by an individual who wants to correct mistakes in his/her own electronic writing. Meanwhile, the current application’s invention is intended for use by a teacher who wants to edit his/her student’s electronic writing by inserting into it editorial markings which can identify for the student the mistakes that he/she has made (See Claim 1’s preamble: “A method that enables one

to give feedback on an electronic writing created with a word processing software by another seeking said feedback and wherein said writing being displayable using said software on a video display of a computer system" and FIG. 9(a)). One wanting to edit only his/her own electronic writing would have no need to create my client's "new version of said electronic writing having inserted editorial markings."

Based upon the above, I ask that this applicant's claims 1-30 be allowed.

I look forward to our telephone conversation today at 4:00 pm. Regards, Larry

10/6/05 – Emailed, Informal Communication:

In anticipation of an upcoming telephone conversation with you regarding this application, would you please give some consideration to the following point before we speak? Thanks. Larry

The most prominent thing for me in your "Response to Arguments" section was your statement "Applicant is arguing¹ the disclosure of the invention, not the claimed limitations."

I'd like to think that you made this comment so as to make me aware of the fact that if I were to add such a limitation to this application's claims that you would then find them allowable.

If my argument had no merit wouldn't you just say so? Instead, you responded not to the merits of my arguments, but with a comment that I was arguing my disclosure and not my claim limitations.

However, the Applicant respectfully asserts that the Examiner is dead wrong on this point as can clearly be seen by noting below the representative, amended Claim 1 to which my arguments were directed:

1. (Currently Amended) A method for providing that enables one to give feedback on an electronic writing created with a word processing software by another seeking said feedback and wherein said writing being displayable using said software on a video display of a computer system, said method comprising the steps of:

¹ "Neither the cited portion, or any other portion, of Newbold discloses "inserting an editorial marking into the original electronic writing – thereby creating an effective new version of the original electronic writing that has inserted into it editorial markings - a version which can be returned to author of the original electronic writing to give him/her feedback, which he/she can use as they like to make any desired changes to his/her electronic writing."

developing a set of editorial markings that are insertable into said writing, selecting from said set of editorial markings a marking to be inserted into said writing, inserting said marking into said electronic writing so as to create a version of said electronic writing that has inserted into said version at least one of said insertable editorial markings, and

saving information pertaining to said inserted marking in said computer system so as to establish a database that documents the use of said inserted markings in said writing.

That Claim 1 has the limitation (e.g., "so as to create a version of said electronic writing that has inserted into said version at least one of said insertable editorial markings") being argued is clearly evident for all to see.

If you now believe that you might have been mistaken in stating that one of the key points/limitations that I was arguing was not in the claims, wouldn't you please consider and comment on the merits of my arguments?

For example, if you agree with me that this limitation is clearly not within the cited reference, you should withdraw your rejections and allow my amended claims. Alternatively, you could suggest how I might further modify these claims to make them acceptable to you.

REQUEST FOR RECONSIDERATION

In view of the above, it is submitted that the Applicant's amended claims are in condition for allowance. Reconsideration and allowance of amended claims 1-30 are requested.

Alternatively, with few amendments, it is submitted that these claims could easily be placed in a condition for allowance. The Applicant hereby requests that the Examiner establish informal communications with the Applicant's Attorney for the purposes of determining what form such amendments might take.

Respectfully submitted,

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11/8/05

Date

CERTIFICATE OF FACSIMILE TRANSMISSION

Date of Transmission: 11/8/05

I hereby certify that this paper, and attachments, if any, is being facsimile transmitted, on the date indicated above, to the U.S. Patent and Trademark Office, Group 2176 at facsimile number 571-273-8300.

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